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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/845,643 | 04/30/2001 | Srikar Rao | | 3965 |

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INDIANAPOLIS, IN 46204

EXAMINER

WONG, STEVEN B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3711

DATE MAILED: 05/14/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,643

Applicant(s)

RAO, SRIKAR

Examiner

Steven Wong

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 9, 10 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 9, 10 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 3, 6, 7, 13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio. Regarding claims 1, 6, 13 and 17, Giglio discloses a golf ball marker and holder comprising a clip (20) and a ball marker (24), which is attached to the clip by a magnet (16). The clip defines a circular recessed cavity (32), which receives the ball marker. It would have been obvious to one of ordinary skill in the art to remove the golf tee attachment surface (48) from the accessory of Giglio in order to provide a simpler device. Further, it would have been obvious to one of ordinary skill in the art to form the clip of Giglio from a monolithic piece in order to simplify construction of the clip by permitting processes such as molding.

Regarding claims 3 and 7, the marker is made from a ferrous material and the ball marker is magnetic.

Regarding claim 16, the ball marker of Giglio obviously possesses a rim that would facilitate removal of the marker from the recess.

Regarding claim 18, the golf ball holder of Giglio is obviously capable of being attached to a shoe and thus, is obviously shaped for attachment to a shoe.

3. Claims 4, 5, 9, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio in view of Kennedy. Regarding claims 4, 9 and 15, Giglio provides a means (32) for removing the ball marker from the cavity.

Kennedy reveals a golf mark retaining device including a recess (16) and an indentation (60) for assisting in grasping the ball marker. It would have been obvious to one of ordinary skill in the art to replace the means (32) of Giglio for removing the ball marker from the cavity with the indentation of Kennedy in order to assist the user in removing the ball marker from the cavity.

Regarding claims 5 and 10, Giglio states that it is well known in the art to provide indicia on the top surface of ball markers such as the name of a golf equipment manufacturer (column 2, lines 8-11).

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio in view of Buckman. Buckman discloses a golf ball marker and carrying tool comprising a recess (4) sized for receiving a ball marker (7) and magnet (6). Note Figure 2 which shows the ball marker protruding slightly past the outer surface of the recess. It would have been obvious to one of ordinary skill in the art to have the ball marker of Giglio extend slightly past the recess in order to facilitate removal of the ball marker.

Response to Arguments

5. Applicant's arguments filed March 12 and 21, 2003 have been fully considered but are not deemed to be persuasive. Applicant's statement that the office action does not address the limitation for the clip to be free of golf tee attachment surfaces is without merit. Attention is drawn to page 2 of the office action where it is stated "It would have been obvious to one of ordinary skill in the art to remove the golf tee attachment surface (48) from the accessory of Giglio in order to provide a simpler device."

Regarding the limitation for the clip to be size for attachment to a shoe, the golf tool of Giglio is obviously capable of being attached to a shoe and thus, is obviously sized for attachment to a shoe. The pile section (40) of the glove, the ball marker (24) and the golf tee (26) all give a frame of reference for the size of the clip of the golf tool and none of these would lead of ordinary skill in the art from believing that the clip is sized so that it is capable of being attached to a golf shoe.

Regarding the limitation for the tool to be monolithic, instant claim 13 defines “a monolithic strip having two portions forming the legs of a generally U-shaped member”. The office action clearly states that it would have been obvious to one of ordinary skill in the art to form the clip of Giglio from a monolithic piece in order to simplify construction of the clip by permitting processes such as molding. The office action does not state that the hook surface for attaching the golf thereto is formed in the monolithic structure. The instant claim uses the open language “comprising” and clearly leaves the possibility for additional structures to be added to the monolithic structure.

The applicant should note that the elimination of the golf tee holder from the tool of Giglio amounts to nothing more than a removal of parts and their associated functions. See *In re Karlson*, 136 USPQ 184 and *In re Wilson et al*, 153 USPQ 740.

The applicant should also note that the formation of the golf tee holder of Giglio as a single integral piece instead of the referenced structures is a matter of obvious engineering choice. See *In re Larson, Russler and Meldahl* 144 USPQ 347.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding the combination of Giglio in view of Kennedy, the applicant argues the motivation to replace the means (32) of Giglio for removing the ball marker with the means (60) of Kennedy for removing his ball marker. However, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Attention is also directed to column 5, lines 11-15 of Kennedy describing the fingernail indentation (60) for facilitating removal of the ball marker. The applicant's argument that the replacement of recess of Giglio with the indentation of Kennedy would render the device inoperable is not seen. The indentation of Kennedy is clearly taught as being capable of engaging the fingertip of a user. Clearly this engagement would permit the ball marker to be lifted from the recess. The combination of Giglio in view of Kennedy is seen as providing a recess (16) with an indentation (60) adjacent thereto.

Regarding claim 15, the "means for" language is noted in positively defining the structure described in applicant's specification. To meet the limitations the examiner need provide the

same structure or obvious equivalents thereto. Here, the combination of Giglio in view of Kennedy provides an obvious equivalent to the structure described in applicant's specification.

Regarding claim 14, the applicant argues that the ball marker storage cavity of Giglio is not suited for modification. However, this is not persuasive as both inventions are directed to golf tools having ball markers removably attached thereto. Replacing the retaining means of Giglio with the retaining means of Buckman would destroy neither reference and, in fact, would still provide golf ball marker retaining means on each tool.

The applicant should also note that the language of claim 14 is such that the rim of the ball marker (24) would appear to anticipate the claim language when interpreted in light of the recess (32).

Conclusion

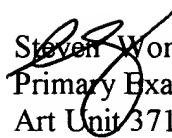
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3579 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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Steven Wong
Primary Examiner
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SBW
May 14, 2003